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10/501126

BA9297USPCT - PETITION UNDER 37 CFR 1.144 FROM REQUIREMENT FOR RESTRICTION  
(AFTER FINAL REJECTION)

Page \_\_\_\_\_ of \_\_\_\_\_

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DU PONT LEGAL BMP BLDG-25 R1375

NO. 8998 P. 2

Rev. 10/93

**PETITION AFTER FINAL  
PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**IN THE APPLICATION OF:**

STEPHEN RAY FOOR ET AL.

CASE NO.: BA9297USPCT

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**MAR 03 2008**

APPLICATION NO.: 10/501126

GROUP ART UNIT: 1615

FILED: JULY 9, 2004

EXAMINER: A. SASAN  
CONFIRMATION NO.: 5564

FOR: BENZAMIDES AND ADVANTAGEOUS COMPOSITIONS THEREFOR FOR USE  
AS FUNGICIDES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION UNDER 37 CFR 1.144  
FROM REQUIREMENT FOR RESTRICTION  
(AFTER FINAL REJECTION)**

This application represents a national filing of a PCT international application and unity of invention criteria are submitted to apply. Claims numbered 1, 2, 4-7, 9, 11, and 17-28 are currently pending. A copy of those claims is appended hereto.

Applicants hereby petition to have claims numbered 1, 2, 6, 7, 9, 11, 21, 22, 23 and 26 fully examined in this application along with the other claims now pending. Applicants submit that by virtue of amendment or dependency, each of these claims should be fully included in the group selected for examination in this application as sharing the common technical feature of that group.

**Brief History**

In an Office Communication dated April 17, 2007, restriction of the original 16 claims was required under 35 U.S.C. 121 and 372 to one of twelve groups. Basically, nine of the groups were related to the nine types of "component (b)" listed in original Claim 1, and at least some of the claims assigned to each of these nine groups were included "partially". The three other groups were related to the three original independent compound claims. Group II was designated to include claims 1, 2, 6-11 (all partially) as well as claims 4 and 5. Applicants note that original Claim 6 depended from Claim 1 and addressed compositions where component (b) comprises at least one compound from each of two different groups selected from (b1), (b2), (b3), (b4), (b5), (b6), (b7), (b8) and (b9). Thus, unlike original

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Claim 7, original Claim 6 did not necessarily require a (b2) compound; but original Claim 6 nevertheless did require at least one compound from each of two different groups.

In an Amendment dated May 9, 2007, Applicants elected Group II relating to certain compositions comprising component (a) compound(s) and component "(b2)" compound(s), and to a method for controlling plant diseases that involves applying the compositions. Applicants requested reconsideration of the restriction; and with particular regard to Claim 7, Applicants submitted that Claim 7 should be completely included in Group II since at least one compound selected from (b2) is included in the composition. In addition, Applicants added a number of new claims, including Claim 21 directed to compositions comprising the (b2) compound famoxadone and a compound selected from a group including non-(b2) compounds; and Claim 22 which depends from Claim 18 and is directed to a composition comprising at least one compound selected from a group including non-(b2) compounds.

An Office communication dated May 30, 2007, indicated that Applicants' submission that Claim 7 should be completely included in Group II was not persuasive. The Office Action maintained that although at least one compound selected from (b2) is included in the composition, in addition at least one compound selected from (b1), (b3), (b6), (b7), (b8) or (b9) is also included; and selecting at least one compound selected from (b1), (b3), (b6), (b7), (b8) or (b9) in addition to (b2) constitutes separate technical features and the search involved for each of these compounds would be different. The restriction requirement was made final. The Office Action also suggested that new Claim 18 which then recited a composition comprising an "(a) component", a "(b2) component" and optionally at least one compound selected from the group of compounds of (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9) "disclosed" a composition with component (a), (b2), and at least one compound that is from a non-elected group. The Office Action withdrew new Claim 18 and new claims 19-22 which depended directly or indirectly from Claim 18 from consideration.

In an Amendment dated September 19, 2007, Claim 1 was amended to inter alia comprise at least one (b2) compound and optionally at least one compound selected from the group consisting of (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9); Claim 18 was amended to an independent claim that inter alia omitted mention of (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9); and new claims 23-27 were added. Claim 6 was also amended to address certain compositions where component (b) comprises at least one compound selected from (b2) and at least one compound selected from the group consisting of (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9). Claims 23 and 26 depend from claims 18 and 24 respectively, and recite that the composition further comprises at least one compound selected from the group consisting of (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9).

The latest Office Action dated December 12, 2007 (which included a final rejection of claims 1, 2, 4-7, 9, 11, 17-20, 24, 25, 27 and 28) agreed that amended Claim 18, new independent Claim 24 as well as certain claims that depended from them should be included

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in Group II. However, the Office Action indicated that claims 21, 22, 23 and 26 would not be included in Group II because the compositions disclosed in these claims "further comprise a compound."

#### Argument

Unity of invention is discussed in MPEP 1850. The requirements of unity of invention shall be fulfilled when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features (see MPEP 1850 and Rule 13.2). Applicants submit that for this application, the special technical feature of Group II has been identified to be a composition for controlling plant diseases caused by fungal plant pathogens comprising (a) at least one compound of formula I of Claim 1, N-oxides and agriculturally suitable salts thereof, and (b) a compound acting at the bc<sub>1</sub> complex of the fungal mitochondrial respiratory electron transfer site. Amended Claim 1 now requires the technical feature of Group II, and Applicants submit that whether or not an optional component of the compositions this claim addresses is also "disclosed" (but not required) in the claim, should clearly not effect the full examination of this claim or of claims 2, 9 and 11 which depend directly or indirectly from Claim 1.

With regard to claims 6, 7, 21, 22, 23 and 26, Applicants submit that these claims also require the technical feature of Group II, even though an additional component may be required for the compositions they address. As indicated in the Amendment dated September 19, 2007, Applicants submit that the test for unity is not whether a separate technical feature is presented, but whether there is a common technical feature. It does not matter if a dependent claim itself even contains a further invention. Subject to Rule 13.1 it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention (see MPEP 1850 and Rule 13.4).

Applicants submit that there is an additional aspect that must be considered in connection with Claim 6 and Claim 7 in order for prosecution of this application to proceed. Applicants note that the combination addressed in Claim 6, by its dependency, includes the sub-combination required by Claim 1, and thus the technical feature of Group II. Likewise, Applicants note that the combination addressed in Claim 7 by its indirect dependency, also includes the sub-combination required by Claim 1, and thus the technical feature of Group II. However, Claim 6 and Claim 7 each require an additional component for the compositions they address, and these claims are amongst those now rejected in this application. Indeed, Claim 7 has always required at least one compound from (b2) and at least one compound from another (b) group recited in the claim; and it has not been clear how this claim could be partially, but not fully included in Group II. Moreover, it is not evident how Claim 6 and

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Claim 7 can be examined and rejected (as they currently are) without considering the additional required feature recited in those claims; and it is not evident how to respond to such rejections. It is also not evident how claims 6 and 7 can be examined while claims 21, 22, 23 and 26 are withdrawn from consideration.

Applicants submit that prior to examination on the merits no dependent claim should be considered to lack unity with the Group II independent claim from which it depends so long as it shares the technical feature of Group II. Moreover, Applicants submit that even where an objection of lack of unity between all of the claims dependent on an independent claim that does not avoid the prior art might be asserted a posteriori, an opportunity should then be afforded to Applicants to select among the dependent claim groups that are asserted not to have an inventive link.

In sum, Applicants submit that all pending claims in this application require the technical feature associated with the group elected for examination. Accordingly, Applicants request withdrawal of the restriction requirement for this application insofar as it pertains to the currently pending claims, and full examination of all of the pending claims in this application. In the event the restriction requirement for this application is somehow found supportable under unity of invention principles, Applicants also request clarification of the basis for examination and rejection of claims 6 and 7 which recite a composition component other than component (a) and component (b2) as an additional feature.

If there are any additional fees for this Petition, please charge our Deposit Account 04-1928.

Respectfully submitted,



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Dated: MARCH 3, 2008

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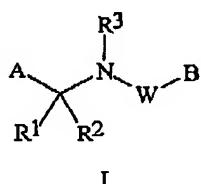
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**Pending Claims**

1. A composition for controlling plant diseases caused by fungal plant pathogens comprising:

(a) at least one compound of Formula I, *N*-oxides and agriculturally suitable salts thereof



wherein

A is a substituted pyridinyl ring;

B is a substituted phenyl ring;

W is C=L or SO<sub>n</sub>;

L is O or S;

R<sup>1</sup> and R<sup>2</sup> are each independently H; or C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>2</sub>-C<sub>6</sub> alkenyl, C<sub>2</sub>-C<sub>6</sub> alkynyl or C<sub>3</sub>-C<sub>6</sub> cycloalkyl, each optionally substituted;

R<sup>3</sup> is H; or C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>2</sub>-C<sub>6</sub> alkenyl, C<sub>2</sub>-C<sub>6</sub> alkynyl, C<sub>3</sub>-C<sub>6</sub> cycloalkyl, C<sub>2</sub>-C<sub>10</sub> alkoxyalkyl, C<sub>2</sub>-C<sub>6</sub> alkylcarbonyl, C<sub>2</sub>-C<sub>6</sub> alkoxy carbonyl, C<sub>2</sub>-C<sub>6</sub> alkylaminocarbonyl or C<sub>3</sub>-C<sub>8</sub> dialkylaminocarbonyl; and

n is 1 or 2; and

(b) at least one compound selected from the group consisting of (b2) compounds acting at the bc<sub>1</sub> complex of the fungal mitochondrial respiratory electron transfer site; and optionally at least one compound selected from the group consisting of

(b1) alkylenebis(dithiocarbamate) fungicides;

(b3) cymoxanil;

(b4) compounds acting at the demethylase enzyme of the sterol biosynthesis pathway;

(b5) morpholine and piperidine compounds that act on the sterol biosynthesis pathway;

(b6) phenylamide fungicides;

(b7) pyrimidinone fungicides;

(b8) phthalimides; and

(b9) fosetyl-aluminum.

2. A composition of Claim 1 in which component (a) is a compound of Formula I wherein

A is a pyridinyl ring substituted with from 1 to 4 R<sup>5</sup>;

B is a phenyl ring substituted with from 1 to 4 R<sup>6</sup>;

W is C=O;

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R<sup>1</sup> and R<sup>2</sup> are each independently H; or C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>2</sub>-C<sub>6</sub> alkenyl, C<sub>2</sub>-C<sub>6</sub> alkynyl or C<sub>3</sub>-C<sub>6</sub> cycloalkyl, each optionally substituted with one or more substituents selected from the group consisting of halogen, CN, NO<sub>2</sub>, hydroxy, C<sub>1</sub>-C<sub>4</sub> alkoxy, C<sub>1</sub>-C<sub>4</sub> alkylthio, C<sub>1</sub>-C<sub>4</sub> alkylsulfinyl, C<sub>1</sub>-C<sub>4</sub> alkylsulfonyl, C<sub>2</sub>-C<sub>4</sub> alkoxy carbonyl, C<sub>1</sub>-C<sub>4</sub> alkylamino, C<sub>2</sub>-C<sub>8</sub> dialkylamino and C<sub>3</sub>-C<sub>6</sub> cycloalkylamino; R<sup>3</sup> is H; and each R<sup>5</sup> and R<sup>6</sup> is independently C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>2</sub>-C<sub>6</sub> alkenyl, C<sub>2</sub>-C<sub>6</sub> alkynyl, C<sub>3</sub>-C<sub>6</sub> cycloalkyl, C<sub>1</sub>-C<sub>6</sub> haloalkyl, C<sub>2</sub>-C<sub>6</sub> haloalkenyl, C<sub>2</sub>-C<sub>6</sub> haloalkynyl, C<sub>3</sub>-C<sub>6</sub> halocycloalkyl, halogen, CN, CO<sub>2</sub>H, CONH<sub>2</sub>, NO<sub>2</sub>, hydroxy, C<sub>1</sub>-C<sub>4</sub> alkoxy, C<sub>1</sub>-C<sub>4</sub> haloalkoxy, C<sub>1</sub>-C<sub>4</sub> alkylthio, C<sub>1</sub>-C<sub>4</sub> alkylsulfinyl, C<sub>1</sub>-C<sub>4</sub> alkylsulfonyl, C<sub>1</sub>-C<sub>4</sub> haloalkylthio, C<sub>1</sub>-C<sub>4</sub> haloalkylsulfinyl, C<sub>1</sub>-C<sub>4</sub> haloalkylsulfonyl, C<sub>1</sub>-C<sub>4</sub> alkylamino, C<sub>2</sub>-C<sub>8</sub> dialkylamino, C<sub>3</sub>-C<sub>6</sub> cycloalkylamino, C<sub>2</sub>-C<sub>6</sub> alkylcarbonyl, C<sub>2</sub>-C<sub>6</sub> alkoxy carbonyl, C<sub>2</sub>-C<sub>6</sub> alkylaminocarbonyl, C<sub>3</sub>-C<sub>8</sub> dialkylaminocarbonyl or C<sub>3</sub>-C<sub>6</sub> trialkylsilyl; or each R<sup>5</sup> and R<sup>6</sup> is independently a phenyl, a benzyl, a phenoxy, a 5- or 6-membered heteroaromatic ring or a 5- or 6-membered nonaromatic heterocyclic ring, each ring optionally substituted with from one to three substituents independently selected from R<sup>7</sup>; or two R<sup>6</sup> attached to contiguous carbon atoms are taken together with said carbon atoms to form a fused phenyl ring, a fused 5- or 6-membered nonaromatic carbocyclic ring, a fused 5- or 6-membered heteroaromatic ring or a fused 5- or 6-membered nonaromatic heterocyclic ring, each fused ring optionally substituted with from one to three substituents independently selected from R<sup>7</sup>; each R<sup>7</sup> is independently C<sub>1</sub>-C<sub>4</sub> alkyl, C<sub>2</sub>-C<sub>4</sub> alkenyl, C<sub>2</sub>-C<sub>4</sub> alkynyl, C<sub>3</sub>-C<sub>6</sub> cycloalkyl, C<sub>1</sub>-C<sub>4</sub> haloalkyl, C<sub>2</sub>-C<sub>4</sub> haloalkenyl, C<sub>2</sub>-C<sub>4</sub> haloalkynyl, C<sub>3</sub>-C<sub>6</sub> halocycloalkyl, halogen, CN, NO<sub>2</sub>, C<sub>1</sub>-C<sub>4</sub> alkoxy, C<sub>1</sub>-C<sub>4</sub> haloalkoxy, C<sub>1</sub>-C<sub>4</sub> alkylthio, C<sub>1</sub>-C<sub>4</sub> alkylsulfinyl, C<sub>1</sub>-C<sub>4</sub> alkylsulfonyl, C<sub>1</sub>-C<sub>4</sub> alkylamino, C<sub>2</sub>-C<sub>8</sub> dialkylamino, C<sub>3</sub>-C<sub>6</sub> cycloalkylamino, C<sub>3</sub>-C<sub>6</sub> (alkyl)cycloalkylamino, C<sub>2</sub>-C<sub>4</sub> alkylcarbonyl, C<sub>2</sub>-C<sub>6</sub> alkoxy carbonyl, C<sub>2</sub>-C<sub>6</sub> alkylaminocarbonyl, C<sub>3</sub>-C<sub>8</sub> dialkylaminocarbonyl or C<sub>3</sub>-C<sub>6</sub> trialkylsilyl.

4. A composition of Claim 2 wherein component (b) is a compound selected from (b2).
5. A composition of Claim 4 wherein component (b) is famoxadone.
6. The composition of Claim 1 wherein component (b) comprises at least one compound selected from (b2) and at least one compound selected from (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9).

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7. The composition of Claim 6 wherein component (b) comprises at least one compound selected from (b2) and at least one compound selected from (b1), (b3), (b6), (b7), (b8) or (b9); wherein the overall weight ratio of component (b) to component (a) is from 30:1 to 1:30; and wherein the weight ratio of component (b2) to component (a) is from 10:1 to 1:1.

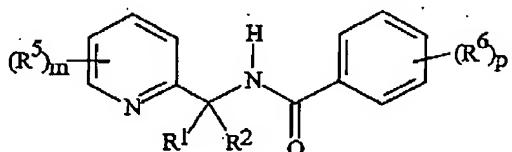
9. A method for controlling plant diseases caused by fungal plant pathogens comprising applying to the plant or portion thereof, or to the plant seed or seedling, a fungicidally effective amount of a composition of Claim 1.

11. The method of Claim 9 wherein the disease to be controlled is caused by the fungal pathogen *Plasmopara viticola*.

17. The composition of Claim 5 wherein component (a) is 2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide.

18. A composition for controlling plant diseases caused by fungal plant pathogens comprising:

(a) a compound of the formula



wherein (R<sup>5</sup>)<sub>m</sub> is 3-Cl-5-CF<sub>3</sub>, R<sup>1</sup> is H, R<sup>2</sup> is H, and (R<sup>6</sup>)<sub>p</sub> is 2,6-di-Cl; and  
(b2) at least one compound selected from compounds acting at the bc1 complex of the fungal mitochondrial respiratory electron transfer site.

19. The composition of Claim 18 comprising a strobilurin fungicide that acts at the bc1 complex of the fungal mitochondrial respiratory electron transfer site.

20. The composition of Claim 18 comprising famoxadone or fenamidone.

21. The composition of Claim 20 comprising famoxadone and a compound selected from the group consisting of mancozeb, maneb, propineb, zineb, cymoxanil, metalaxyl, benalaxyl, oxadixyl, 6-ido-3-propyl-2-propyloxy-4(3H)-quinazolinone, 6-chloro-2-propoxy-3-propylthieno[2,3-d]pyrimidin-4(3H)-one, folpet, captan and fosetyl-aluminum.

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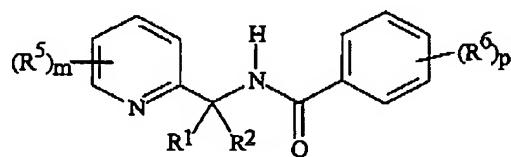
22. The composition of Claim 18 comprising at least one compound selected from the groups consisting of acibenzolar, benalaxyl, benomyl, blasticidin-S, Bordeaux mixture (tribasic copper sulfate), carpropamid, captafol, captan, carbendazim, chloroneb, chlorothalonil, copper oxychloride, copper salts such as copper sulfate and copper hydroxide, cyazofamid, cymoxanil, cyprodinil, (S)-3,5-dichloro-N-(3-chloro-1-ethyl-1-methyl- 2-oxopropyl)-4-methylbenzamide (RH 7281), dicloctemet (S-2900), diclomezine, dicloran, dimethomorph, diniconazole-M, dodemorph, dodine, edifenphos, fencaramid (SZX0722), fenpiclonil, fentin acetate, fentin hydroxide, fluazinam, fludioxonil, flumetover (RPA 403397), flutolanil, folpet, fosetyl-aluminum, furalaxyl, furametapyr (S-82658), iprobenfos, iprodione, isoprothiolane, iprovalicarb, kasugamycin, mancozeb, maneb, mefenoxam, mepronil, metalaxyl, metiram-zinc, myclobutanil, neo-asozin (ferric methanearsonate), oxadixyl, pencycuron, prochloraz, procymidone, propamocarb, propineb, pyrifenoxy, pyrimethanil, pyroquilon, quinoxyfen, spiroxamine, sulfur, thifluzamide, thiophanate-methyl, thiram, triadimefon, tricyclazole, validamycin, vinclozolin, zineb and zoxamid.

23. The composition of Claim 18 further comprising at least one compound selected from the group consisting of

- (b1) alkylenebis(dithiocarbamate) fungicides;
- (b3) cymoxanil;
- (b4) compounds acting at the demethylase enzyme of the sterol biosynthesis pathway;
- (b5) morpholine and piperidine compounds that act on the sterol biosynthesis pathway;
- (b6) phenylamide fungicides;
- (b7) pyrimidinone fungicides;
- (b8) phthalimides; and
- (b9) fosetyl-aluminum.

24. A composition for controlling plant diseases caused by fungal plant pathogens comprising a synergistic combination of:

(a) a compound of the formula



wherein (R<sup>5</sup>)<sub>m</sub> is 3-Cl-5-CF<sub>3</sub>, R<sup>1</sup> is H, R<sup>2</sup> is H, and (R<sup>6</sup>)<sub>p</sub> is 2,6-di-Cl; and  
 (b2) at least one compound selected from compounds acting at the bc1 complex of the fungal mitochondrial respiratory electron transfer site.

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25. The composition of Claim 24 comprising famoxadone.
26. The composition of Claim 24 further comprising at least one compound selected from the group consisting of
  - (b1) alkylenebis(dithiocarbamate) fungicides;
  - (b3) cymoxanil;
  - (b4) compounds acting at the demethylase enzyme of the sterol biosynthesis pathway;
  - (b5) morpholine and piperidine compounds that act on the sterol biosynthesis pathway;
  - (b6) phenylamide fungicides;
  - (b7) pyrimidinone fungicides;
  - (b8) phthalimides; and
  - (b9) fosetyl-aluminum.
27. A method for controlling plant diseases caused by fungal plant pathogens comprising applying to the plant or portion thereof, or to the plant seed or seedling, a synergistic fungicidally effective amount of a composition of Claim 24.
28. The method of Claim 27 wherein the composition comprises famoxadone and the disease to be controlled is caused by the fungal pathogen *Phytophthora infestans*.